

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-14 are pending, all of which are amended. The amendments remove the parenthetical expressions in the claims, which does not affect their scope (MPEP § 608.01(m), place the preambles in more idiomatic English, and amend the claims to better correspond with U.S. claim drafting practice. It is believed no new matter is involved. Claim 1 is independent.

The Examiner is respectfully requested to reconsider the rejections in view of the claim amendments and the remarks set forth herein.

Drawings

Applicants thank the Examiner for indicating that the drawings filed with this Application are accepted.

Claim for Priority

Applicants thank the Examiner for acknowledging the Applicants' claim for foreign priority, and for receipt of the priority document.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,734,490 to Rabarot et al. ("Rabarot"). This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to

be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under § 103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner is expected to make the factual determinations set forth in *Graham v John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24

USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Claim 1, as amended, recites a method of producing a compact movable structure for a light shaping unit comprising: forming a light shaping unit from a material provided on a carrier of another material; and forming a micromechanical structure from the carrier which is adapted to move the light shaping unit, wherein the light shaping unit is formed before the micromechanical structure is formed.

Applicants respectfully submit that Rabarot is significantly different from the claimed invention. For example, Rabarot moves its lens 84 using the very same silica layer 80 that is used to form its microlens 84, and its micromechanical structure 82, which is adapted to move lens 84, is clearly not its carrier (substrate 86). Accordingly, Rabarot's carrier (substrate 86) does not disclose the claimed invention because it is not a micromechanical structure formed from its carrier (substrate 86) adapted to move the light shaping unit (lens 84).

Moreover, Rabarot fails to disclose, either explicitly or inherently (i.e., not just possibly and not just probably, but necessarily), that the forming of its light shaping unit (lens 84) takes place before the forming of the micromechanical structure (82), as recited. In fact, a reading of col. 6, lines 13-38 of Rabarot reveals that all that is disclosed in this regard are statements that microbeams and microlenses are formed by the same process. Nothing specific is said about the order in which the microlenses and the microbeams are made, which means that this feature of the claimed invention is neither explicitly or inherently disclosed by Rabarot.

Nor is Rabarot's light shaping unit (84) made of a different material than the micromechanical structure (82), as claimed, because elements 82 and 84 are formed from the very same silica layer (col. 6, lines 49-60).

Thus, the subject matter of claim 1, as amended, is not disclosed, suggested, or otherwise rendered obvious, by Rabarot.

Moreover, Applicants respectfully submit that all dependent claims are in condition for allowance at least because of their dependency from allowable independent claim 1.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-14 under 35 U.S.C. § 103(a) are respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Robert J. Webster (Reg. No. 46,472) at (703) 208-5000.

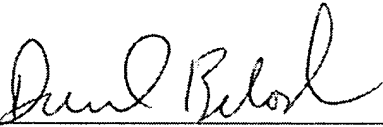
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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